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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,634	12/04/2000	Douglas J. Woodnorth	08935-226001 / M-4934	3041
26161	7590	08/19/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,634

Applicant(s)

WOODNORTH, DOUGLAS J.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9, 13-20 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9, 13-20 and 44-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3629

DETAILED ACTION

Examiner's Note

Examiner suggests to substitute a phrase "*communicating a bill*" in claim 5 with "*communicating bill information*"; and a phrase "*bill is communicated*" in claim 6 with "*bill information is communicated*".

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-9, 13-20 and 44-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US 5,349,535) in view of Thandiwe (US 6,456,036).

Independent Claim.

Claim 14. Gupta teaches a vehicle battery condition monitoring and recording method and system, comprising:

Providing a battery to a user to be used in a user's device (a car) (C. 5, L. 14-36); determining the usage of the battery; determining a fee based on the usage (C. 3, L. 47-50).

Gupta does not specifically teach that said battery is a portable battery, and that said user's device is a hand-portable device.

Thandiwe teaches a method and system for a battery having a network communication interface, including providing a smart battery for use with cellular telephone or a personal digital assistant (PDA) (C. 2, L. 10-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include that said battery is used for powering a user's hand-portable device, as disclosed in Thandiwe, because it would advantageously increase the application field of the invention, thereby generate more revenue.

Dependent Claims.

Claim 5. Communicating usage information (Gupta; C. 10, L. 28-35).

Claim 6. Thandiwe teaches: communicating usage information over the Internet (C. 2, L. 14-16). The motivation to combine Gupta with Thandiwe would be to make the information instantly available at any remote location adapted to be connected to the Internet.

Claims 7-8. Providing the customer with option to purchase the battery, or to lease it. Leasing option inherently indicates absence of purchase fee (Gupta; C. 3, L. 29-30).

Claim 9. Thandiwe teaches said method and system, wherein the device is a communication device (C. 2, L. 16-17). The motivation to combine Gupta with Thandiwe would be to advantageously increase the application field of the invention, thereby generate more revenue.

Claim 13. Said method and system, wherein the battery usage is based on recharge cycles (Gupta; C. 7, L. 31-36, 42-43, 48-49).

Claim 15. See claim 14.

Claim 16. See claim 6.

Claim 17. See claim 14.

Claim 18. Providing a plurality of charging stations, where the fee for replacement or recharging is based on the usage and/or said terms (Gupta; C. 9, L. 55-58; C. 11, L. 30-45).

Claim 19. See claim 14.

Claim 20. Providing a battery for a device (Gupta; C. 5, L. 14-36).

Information as to *single-use* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Gupta in view of Thandiwe would be performed the same regardless of the type of said portable battery.

Claim 44. Thandiwe teaches said method and system, wherein the device is a telephone (C. 2, L. 17). The motivation to combine Gupta with Thandiwe would be to advantageously increase the application field of the invention, thereby generate more revenue.

Claim 45. Thandiwe teaches said method and system, wherein the device is a computer (C. 2, L. 18). The motivation to combine Gupta with Thandiwe would be to advantageously increase the application field of the invention, thereby generate more revenue.

Claim 46. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *power tool* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 47. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *personal care product* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703

Art Unit: 3629

F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175

F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 48. Providing a battery for a device (Gupta; C. 5, L. 14-36).

Information as to *electric razor* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack 703*

F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175

F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 49. Providing a battery for a device (Gupta; C. 5, L. 14-36).

Information as to *the personal care product is an electric toothbrush* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 50. Providing a battery with a device (car) (Gupta; C. 9, L. 14-37).

Claim 51. See claim 14.

Claim 52. See claim 14.

Claim 53. Providing a rechargeable battery for a device (Gupta; C. 5, L. 14-36).

Response to Arguments

Applicant's arguments filed 5/03/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that Gupta does not teach a hand-portable consumer device, the examiner points out that Thandiwe is applied for this feature. The motivation to combine Gupta with Thandiwe would be to advantageously increase the application field of the invention, thereby generate more revenue (See discussion above).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references teach use of a battery for a user's device, wherein said battery includes a network communication interface for communicating battery usage information to a remote location. The motivation to combine Gupta with Thandiwe would be to advantageously increase the application field of the invention, thereby generate more revenue (See discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3629

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

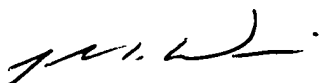
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or faxed to:

(703) 305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.


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